



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER 12 FILING DATE 1 95 AN FIRST NAMED INVENTOR R ATTORNEY DOCKET NO. 1

PAUL T CLARK
FISH AND RICHARDSON
225 FRANKLIN STREET
BOSTON MA 02110-2804

33M1/0617

HARRIS, S

EXAMINER

ART UNIT

PAPER NUMBER

3311

06/17/96

DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892.
2. ☒ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☒ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 1-24 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☒ Claims 1-16 are allowed.

4. ☒ Claims 17-24 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

203

Art Unit: 3311

Claim Rejections - 35 USC § 112

1. Claims 18-24 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18: The elements recited are not structurally connected and present a mere cataloging of elements.

Claim 19: It is not clear as to which structure is being claimed. It is suggested that proper Markush format is used.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

3. Claim 17 is rejected under 35 U.S.C. § 103 as being unpatentable over Tankovich. Tankovich discloses the claimed

204

Serial Number: 08/382122

-3-

Art Unit: 3311

method of removing hair with the exception of providing the particulars of the irradiation parameters recited.

It would have been obvious to an artisan having ordinary skill in the art to have provided the method of removing hair of Tankovich with the particular irradiation parameters in as much as routine experimentation would yield optimum results and therefore varying the parameters would have been different in degree but not in kind to the results.

4. Claim 24 is rejected under 35 U.S.C. § 103 as being unpatentable over Hoskin. Hoskin discloses the claimed device having means for generating optical radiation 10 and an irradiating unit including a contact device 2 being optically transparent (see col. 3 lns.6-19). However, Hoskin fails to teach of the material of the transparent material being sapphire.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the contact device with the material being sapphire for facilitating optical coupling.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or

205

Serial Number: 08/382122

-4-

Art Unit: 3311

on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 18-23 are rejected under 35 U.S.C. § 102(b) as being anticipated by Hoskin et al. Hoskin discloses the claimed device having means for generating optical radiation 10 and an irradiating unit including a contact device 2 being optically transparent (see col. 3 lns.6-19).

Allowable Subject Matter

7. Claims 1-16 are allowable over the prior art of record.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ortiz and Chess '172 are cited as teaching of similar contact laser devices as claimed.

Any inquiry concerning this communication should be directed to Sonya Harris-Ogugua at telephone number (703) 308-2216.

SHO
S.Harris-Ogugua

June 10, 1996

Angela D. Sykes

ANGELA D. SYKES
SUPERVISORY PATENT EXAMINER
GROUP 3300

206